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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/053,387

01/17/2002

Jian Ling Ding

17644-68

1539

33717 7590 04/03/2007

GREENBERG TRAURIG LLP

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EXAMINER

GHALI, ISIS A D

ART UNIT

PAPER NUMBER

1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/053,387	DING ET AL.	
	Examiner	Art Unit	
	Isis A. Ghali	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/0420/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-8,10,13,16 and 18-38 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5-8,10,13 and 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 32-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The receipt is acknowledged of applicants' amendment filed 01/04/2007.

Claims 1, 4, 9, 11, 12, 14, 15, 17 have been canceled.

Claims 2, 3, 5-8, 10, 13, 16, 18-38 are pending.

This application contains claims 2, 3, 5-8, 10, 13, 18-31 drawn to an invention nonelected with traverse in the reply filed 03/12/2004, and have been withdrawn from consideration. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 16 and 32-38 are included in the prosecution.

The following rejection has been over come by applicants' amendment and remarks:

The rejection of claim 16 under 35 U.S.C. 112, second paragraph as being indefinite.

The following rejections have been discussed in the previous office action, and are maintained for reasons of record:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 32, 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,335,026 ('026).

US '026 disclosed an adhesive composition for application to the skin as an adhesive bandage and tape (col.1, lines 7-11; col.3, lines 50-55). The composition comprises ethylene-propylene-diene monomer terpolymer wherein the ratio of ethylene to propylene is 3:1, i.e. 75% ethylene and 25% propylene (col.2, lines 57-61). The composition comprises up to 20% of silica, which disclosed by applicants as hydrophilic particles (col.4, lines 9-10; col.6, lines 31-32). The composition further comprises polyisobutylene, styrene block copolymer in an amount of 25-42%, elastomer stabilizer, pigments, and anti-oxidants, which read on the active agent, disclosed by applicants (col.2, lines 20-33, 42-44; col.3, lines 30-33; col.5, lines 27-29; col.5, examples I-III).

Response to Arguments

3. Applicant's arguments filed 01/04/2007 have been fully considered but they are not persuasive. Applicants traverse this rejection by arguing that:

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- US '026 requires rubber with the terpolymer, while the present invention can function without the same quantity of rubber.

In response to this argument, applicants' attention is directed to the scope of the claims that is directed to composition, and all the elements of the composition are taught by the prior art. The expression "comprising" of the claims' language permits the present of rubber or any other ingredient, active or inactive, even in major amounts. It is further argued that the present invention requires rubber including styrenic rubber and polyisobutylene, and US '026 disclosed polyisoprene and styrene block copolymer that meet claim 36 that recites "styrenic polymers.

- Applicants argue that the ratio of 3:1 disclosed by US '026 is the ratio of ethylene-propylene-diene monomer to rubber and not the ratio of ethylene to propylene as instantly claimed.

In response to this argument, applicants' attention is directed to col.2, lines 59-61 where the reference clearly stated: "this invention is an EODM (ethylene-propylene-diene monomer) terpolymer **wherein the ratio of ethylene to propylene monomer** is approximately **3:1** by weight". The ratio of 3:1 is equivalent to 75% to 25%. Therefore the claimed ratio/percentage of ethylene to propylene is met by the US '026.

- Applicants argue that US '026 is non-enabling for rubber as it refers to the genus of rubber, and the present invention does not require the same rubber disclosed by the reference.

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In response to this argument, it is argued that the disclosure of US '026 is enabling to the rubber as it disclosed specific rubbers to practice their invention including styrenic polymers as claimed by applicants.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '026 in view of US 5,750,134 ('134).

The teachings of US '026 are discussed above. However, US '026 does not expressly teach the butyl rubber as a stabilizer, but recognized the addition of stabilizer to the composition comprising EPDM.

The specific stabilizer claimed by applicant does not impart patentability to the claims, absent evidence to the contrary.

US '134 teaches adhesive composition that is suitable for delivering systemically and locally active agents, wherein the composition comprises elastomeric component such as butyl rubber (abstract; col.3, lines 5-15; col.4, lines 50-65). The elastomeric component renders the ultimate composition be worn comfortably by the user and the composition does not exhibit excessive cold flow when stored at room temperature (col.4, lines 42-49).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to deliver the adhesive composition comprising EPDM and elastomer as disclosed by US '026 and replace the stabilizer by the butyl rubber disclosed by US '134, motivated by the teaching of US '134 that the elastomeric component renders the ultimate composition be worn comfortably by the user and the composition does not exhibit excessive cold flow when stored at room temperature, with reasonable expectation of having adhesive composition comprising EPDM and butyl rubber that is worn comfortable by the user that exhibits minimal cold flow.

Response to Arguments

7. Applicant's arguments filed 01/04/2007 have been fully considered but they are not persuasive. Applicants traverse this rejection by arguing that:

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- Combining the teaching of US '026 and US '134 constitute impermissible hindsight because the combination was long felt but unresolved, and application of subject matter of US '134 would seem obvious after reading inventor's disclosure

In response to this argument, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

- Applicants argue that US '026 was available over 20 years before the present invention and US '134 over 7 years, and a long-standing need was addressed by the present inventors.

In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). In any event, at the time of the invention, both US '026 and US '134 were available.

- Applicants argue that the combination of EPDM and the subject matter of US '134 as a whole would still be undisclosing the present invention.

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In response to this argument, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both of the references are in the field of applicant's endeavor. US '134 is relied upon for the sole teaching of the suitability of butyl rubber in compositions applied to the skin. US '134 teaches that such elastomeric component renders the ultimate composition be worn comfortably by the user and the composition does not exhibit excessive cold flow when stored at room temperature, and this teaching would have motivated one having ordinary skill in the art to add elastomeric component to adhesive skin composition disclosed by US '026, with reasonable expectation of having adhesive composition comprising EPDM and butyl rubber that is worn comfortable by the user that exhibits minimal cold flow.

8. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '026 in view of US 6,805,961 (961).

The teachings of US '026 are discussed above. However, US '026 does not expressly teach the composition further comprises ethylene propylene elastomer, but recognized the addition to elastomer to the composition comprising EPDM.

The specific claimed elastomer does not impart patentability to the claims, absent evidence to the contrary.

US '961 teaches an adhesive tape comprising amorphous polyolefin based on propylene that provides improved relaxation properties and flexibility of the tape (col.6, lines 1-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to deliver the adhesive composition comprising EPDM and elastomer as disclosed by US '026 and replace the elastomer by the amorphous propylene based polyolefin disclosed by US '961, motivated by the teaching of US '961 that the amorphous propylene based polyolefin provides improved relaxation properties and flexibility of the tape, with reasonable expectation of having adhesive composition comprising EPDM and amorphous propylene based polyolefin that has improved relaxation properties and flexibility.

Response to Arguments

9. Applicant's arguments filed 01/04/2007 have been fully considered but they are not persuasive. Applicants traverse the rejection by arguing that:

- The rejection is abased on impermissible hindsight reasoning.

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In response to this argument, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

- Applicants argue that the combined teaching of US '026 and US '961 does not teach that the combination used to achieve better fluid absorption.

In response to this argument, the examiner position is that a conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). US '961 is relied upon for the sole teaching of suitability of propylene in skin adhesive compositions. US '961 teaches that the amorphous propylene based polyolefin provides improved relaxation properties and flexibility of the tape, and this teaching would have motivated one skilled in the art to replace the elastomer disclosed by US '026 by amorphous propylene based polyolefin as disclosed by US '961. In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rationale to modify or to combine

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the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103 (a), and a *prima facie* case of obviousness has been established.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

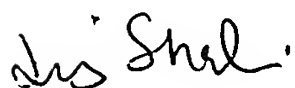
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
Art Unit 1615

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ISIS GHALI
PRIMARY EXAMINER